

REMARKS

The claims have been amended to correct minor typographical errors. In addition, new Claim 31 has been added. New Claim 31 is believed to be supported at page 30 of the specification. No new matter is believed to be added by entry of these amendments.

The Office has required restriction in the present application as follows:

Group I: Claims 1, 2, 6-7, 9-12, drawn to a process for preparing D-pantothenic acid using a Coryneform bacteria which has an attenuated poxB gene, wherein said gene is that of SEQ ID NO: 12;

Group II: Claims 1, 3, 6-7, 9-12, drawn to a process for preparing D-pantothenic acid using a Coryneform bacteria which has an attenuated poxB gene, wherein said gene is that of SEQ ID NO: 6;

Group III: Claims 1, 4, 6-7, 9-12, drawn to a process for preparing D-pantothenic acid using a Coryneform bacteria which has an attenuated poxB gene, wherein said gene is that of SEQ ID NO: 7;

Group IV: Claims 1, 5-7, 9-12, drawn to a process for preparing D-pantothenic acid using a Coryneform bacteria which has an attenuated poxB gene, wherein said gene is that of SEQ ID NO: 4;

Group V: Claims 1, 6-12, drawn to a process for preparing D-pantothenic acid using a Coryneform bacteria which has an attenuated poxB gene, wherein said gene is that of SEQ ID NO: 1;

Group VI: Claim 13, drawn to the E. coli strain DSM 13114;

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Group VII: Claims 14-18, drawn to a process for producing D-pantothenic acid by transforming a Coryneform bacteria with a vector comprising SEQ ID NO: 3, and selecting a transformant with attenuated poxB expression, wherein said poxB gene hybridizes under stringent conditions to the polynucleotide of SEQ ID NO: 1;

Group VIII: Claims 19-21, drawn to a Coryneform bacteria comprising an attenuated poxB gene, wherein said gene comprises the polynucleotide of SEQ ID NO: 12;

Group IX: Claims 22-27, drawn to a process for producing D-pantothenic acid by transforming a Coryneform bacteria with a vector comprising SEQ ID NO: 6 and SEQ ID NO: 7, and selecting a transformant with attenuated poxB expression, wherein said poxB gene hybridizes under stringent conditions to the polynucleotide of SEQ ID NO: 1;

Group X: Claim 28, drawn to the polynucleotide of SEQ ID NO: 6;

Group XI: Claim 29, drawn to the polynucleotide of SEQ ID NO: 7; and

Group XII: Claim 30, drawn to the polynucleotide of SEQ ID NO: 12.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the inventions of the following Groups as related as product and process of use:

Groups I and XII;

Groups II and X;

Groups III and XI;

Groups I and VIII; and

Groups IX and X-XI.

In support thereof, the Office states that “the DNA of Invention XII can be used to recombinantly produce the corresponding polypeptide as well as in the process of Invention I”; “the DNA of Invention X can be used to recombinantly produce the corresponding polypeptide as well as in the process of Invention II”; “the DNA of Invention XI can be used to recombinantly produce the corresponding polypeptide as well as in the process of Invention III”; “the bacteria of Invention VIII can be used in the process of Invention I as well as to produce proteins which are specific to such bacteria”; and “the polynucleotides of Inventions X-XI can be used in the process of Invention IX as well as to recombinantly produce the corresponding proteins”. However, Applicants respectfully submit that these statements are merely conclusory, and unsupported by further examples or reasoning. Moreover, even if the allegations of the Office are correct, there is no evidence of record showing that the proposed alternative uses are materially different from the claimed processes. Accordingly, Applicants respectfully submit that the Requirement for Restriction is improper, and request that it be withdrawn.

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The Office has also characterized the inventions of the following Groups as “unrelated”:

Groups I-V, VII, IX, and VI;

Groups II-V, VII, IX, and VIII; and

Groups I-V, VII, and IX.

However, Applicants note that the MPEP describes unrelated inventions as, for example, “an article of apparel such as a shoe, and a locomotive bearing”, or “a process of painting a house and a process of boring a well.” MPEP § 806.04(A). Thus, unrelated inventions, as defined by the MPEP, are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. Applicants make no statement with regard to the patentable distinctness of the inventions of these Groups, but respectfully submit that the Office has not shown how the inventions of these Groups meet the standard of “unrelatedness” of MPEP § 806.04(A). Accordingly, Applicants respectfully submit that the Requirement for Restriction is improper, and request that it be withdrawn.

The Office also states that the inventions of Groups VI, VIII, and X-XII “comprise a chemically unrelated structure”. Applicants respectfully submit that Office has again failed to show how the inventions of these Groups meet the standard of “unrelatedness” of MPEP § 806.04(A), as discussed above. Accordingly, Applicants respectfully submit that the Requirement for Restriction is improper, and request that it be withdrawn.

Moreover, MPEP §803 states:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

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Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

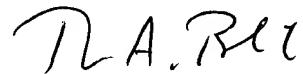
Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction.

Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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